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IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No. 416

ZERO MANUFACTURING COMPANY, INC., *Petitioner*

v.

MISSISSIPPI MILK PRODUCERS ASSOCIATION, *Respondent*

REPLY BRIEF TO RESPONDENT'S OPPOSITION TO PETITION FOR CERTIORARI

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PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D. C.

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The respondent's argument to the Court is essentially as follows:

1. Petitioner is asking the Supreme Court to judge the credibility of an "expert witness".

2. It cannot be assumed that the evidence of the particular witness controlled the decisions.

3. In any event, the expert was fully qualified in the art of refrigerating milk tanks.

4. The Court below properly recognized the rule of commercial success; and

5. The issue is not one of broad interest.

In reply to the foregoing, the petitioner respectfully points out:

1. There is no question of the *credibility,* as such, of respondent's "expert". The issue which the petitioner raises is whether an opinion as to what is or is not obvious "to a person having ordinary skill in the art" to which the subject matter of the invention pertains can invalidate a patent under 35 U.S.C. 103 if that opinion is from a person admittedly *not* skilled in the art. Since 35 U.S.C. 103 is explicit that the question of obviousness is to be determined as viewed by a person having ordinary skill in the art, it would seem elemental that such views are requisite if the statutory provision is to be applied to invalidate a patent.

2. The lower court decisions fairly parroted respondent's "expert" in invalidating petitioner's patents. Respondent has never contended that petitioner's experts suggested that petitioner's invention was obvious. To the contrary, the testimony of Professor March, a true expert in the field, concerned the trade and the revolutionary impact the invention has had in dairy farming. Respondent's suggestion at this late date that the decisions were based upon other than Dean Fischer's testimony is a red herring.

3. Contrary to respondent's implication, there is no testimony that Dean Fischer ever had anything to do with the refrigeration of milk tanks. His degree was in electrical engineering (R. 622.) Refrigeration was one of his hobbies (R. 623). But even if he could be considered a refrigeration expert, by no stretch of the imagination does this make him an expert in the dairy industry art. Dean Fischer was personable and articu-

late. But he was simply in no position to evaluate and testify concerning the effects of the prior teachings on a person skilled in the dairy industry art—particularly where such prior teachings appeared or proved in practice so impracticable as to lead away from, rather than towards, the successful invention.

4. Petitioner does not argue that the lower courts failed to recognize the rule of commercial success. Petitioner's complaint is that the Fifth Circuit Court misapplied the "doubt followed by acclaim" doctrine of *U. S.* v. *Adams,* 15 L. Ed. 2nd, 572, and the "long felt want" doctrine as applied in cited Second Circuit cases. On this, however, respondent fails to comment.

5. Petitioner fully appreciates that the Supreme Court must limit its full consideration to cases appearing to have national importance. Failure of the Court to grant certiorari is not indicative of the Court's agreement with the lower courts' decisions. Indeed, should the petition not be granted, the lower courts' decisions are still not binding as between other possible litigants involving the same patents should petitioner elect to pursue them. But, while petitioner, as any litigant, is disturbed by losing the case, it is also disturbed—perhaps more so—by *why* it lost.

It would seem axiomatic invention and inventors are important. The impacts of gun powder, the printing press, the steam engine and the airplane on civilization are self-evident. John Kenneth Galbraith notes in *The Affluent Society*[1] that technological innovation is one of five basic ways to increase production—the output of the economic system, and that in recent times a growing share of the increase is attributable to tech-

[1] See Chapt. IX, Sec. III.

nological advance and a declining share to mere increases in capital and labor. Ultimately one of the species—perhaps the most important of those paid for technical advance—are patents.

For a period of over fifteen years from the *Great A & P Tea Co.* v. *Supermarket Equipment Corp.*, 340 U.S. 147 (1950) to *Graham* v. *John Deere Co.*, 15 L. Ed. 2d 545, and *United States* v. *Adams*, 15 L. Ed. 2d, 572 (1966), this Court concerned itself with controversies, albeit important, but other than the criteria of patentability. With an intervening revision of the patent statutes, it is therefore not too surprising that the federal judicial circuits have markedly contrasted in their evaluation of patentability, as noted previously on page 14 of the Petition.

It is submitted that largely due to present patent trial practices—as exemplified by this case—problems concerning the sound application of 35 U.S.C. 103 have not been laid to rest by *Graham* v. *John Deere Co.* and *United States* v. *Adams, supra.* While trial courts may be faced with difficult choices where experts conflict, if they are to gage invention under 35 U.S.C. 103, they deserve better than they have been getting which should at least include the advice of experts skilled in the particular art involved.

Insofar as Counsel for petitioner can ascertain, the issue is novel. While its determination may relegate a number of expert experts now thriving in patent trial arenas to obsolescence, the exercise of judicial power in the patent field should gain in uniformity and predictability and seem less of a wheel of fortune than now regarded.

Although the natural reluctance of Courts—generally with minimal engineering training and experience—to embroil themselves in patent cases is appreciated, it is believed of *significant* national interest that this Court promptly invoke its powers of review whenever inconsistencies develop between Circuits or it appears that a particular circuit is not applying the correct standards of patentability.

A strong indication that the Fifth Circuit is not applying the standard of patentability found applicable in recent decisions by this Court and as applied by other circuits, may be found in the recent decision of *Up-Right, Inc.* v. *Safway Products, Inc. et al.*, 150 USPQ 579 (5 Cir. 1966) where Senior Judge Jones (who presided as Chief Judge in *Adams et al.* v. *United States*, 141 USPQ 361 (C. Cls. 1964)) was a member of the appeal panel. Here Senior Judge Jones (sitting with the Fifth Circuit Court of Appeals) dissented from action finding a patent invalid for want of "non-obviousness" over the prior art, for reasons, in part, as follows:

> I respectfully dissent. I feel strongly that the patent in suit passes the test of non-obviousness, formulated by the Patent Act of 1952, 35 U.S.C. Sec. 103 (1964), and construed by the Supreme Court in Graham v. John Deere Co., 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed. 2d 545, 148 USPQ 459 (1966). The majority of this court, and the court below, although professing to be guided by the factual inquiries specified in Graham, in my judgment misapply these tests and thereby reach an erroneous legal conclusion.
>
> A patent awarded by the Patent Office is to be presumed valid, and the burden of establishing

invalidity falls on the party asserting it. 35 U.S.C. SEC. 282 (1964). "The primary responsibility for sifting out unpatentable material lies in the Patent Office." Graham, supra, at 18, 148 USPQ at 467. The majority here gives emphasis to the fact that none of the prior art considered by the District Court was before the Patent Office when it granted the patent in suit. But the party attacking the validity of a claim can always find references which the Patent Office did not consider. The question is whether the references are of such significance that the presumption of validity is overcome and the decision of the Patent Office may be set aside. Otto v. Koppers Co., 246 F.2d 789, 114 USPQ 188 (4th Cir. 1957), cer. denied, 355 U.S. 939, 116 USPQ 602 (1958). Nowhere has appellee attempted to show directly that the prior art which the Patent Office did consider was in fact insufficient in comparison with the references introduced before the District Court.

* * * * *

In ascertaining the obviousness or non-obviousness we are not limited to an examination of prior art. If validity is in question, then "commercial success, long felt but unsolved need, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter * * *. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.". Graham, supra, at 17-18, 148 USPQ at 467. Admittedly commercial success in itself does not support patentability, Great Atl. & Pac. Tea Co. v. Supermarket Equip. Corp., 340 U.S. 147, 153, 71 S.Ct. 127, 95 L.Ed. 162, 87 USPQ 303, 306 (1950), but once novelty and utility have been established, as they have been with respect to the patent in suit, commercial success weighs heavily against contention that the claims in issue were obvious to skilled mechanics in the same field.

Loom Co. v. Higgins, 105 U.S. 580, 26 L.Ed. 1177 (1881); Otto v. Koppers Co., supra, at 799-800, 114 USPQ at 197.

* * * * *

My conclusion is that appellant had *invented* something, something not obvious to others, something not a mere mechanical improvement. It is almost a reflection on the skilled artisans and mechanics of the vast building trade of this country to hold that they overlooked so important a development, but plodded along with clumsier and more expensive methods. I prefer to believe in the skill of these mechanics and artisans. It is plain they welcome the Up-Right scaffold.

By holding the patent in suit invalid, we have done not only an injustice to appellant but have placed an unreasonable and discouraging burden on future inventors. For these reasons I cannot join the majority.

Not unexpectedly, respondent in its brief attempts to depreciate petitioner's invention. The invention involves the process of milking. Almost everyone is directly affected by milk. As Professor March pointed out, the bulk milk tank system is rapidly displacing the can system in the United States and the trend is towards petitioner's particular system which includes the vacuum bulk milk tank. The elimination of the releaser in petitioner's system eliminates a cause of milk rancidity. The reserve vacuum decreases vacuum variation at the teats—a major contributor to mastitis. The vacuumized tank lends itself to effective automatic cleaning. As more fully outlined in the Petition, these and other advantages make petitioner's invention a major advance in the dairy industry. Thus we are not involved with a door knob or eraser on a pencil,

but an important technological advance which directly affects us all.[1]

CONCLUSION

The U.S. Circuit Court of Appeals for the Fifth Circuit has over-reacted to this Court's decisions in *Graham* v. *John Deere Co.* and *United States* v. *Adams, supra.* This is evidenced by the instant case and delineated by Senior Judge Jones' vigorous dissent in the subsequent case of *Up-Right, Inc.* v. *Safway Products, Inc., supra.* Important issues and an important invention is involved. The petition for a writ of certiorari should be granted.

Respectfully submitted,

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[1] Contrary to the lower court decisions, history will probably side with Zero as to the importance of its development. Aside from the commercial success and other indicia of invention presented in evidence, petitioner was one of 16 concerns chosen to present a mechanical display at the 1961 Mechanical Industries Patent Exhibit in the Department of Commerce Building, Washington, D. C. held in celebration of the 125th Anniversary of the U. S. Patent Office. In a recent industrial arts exhibition in Moscow, USSR, a Zero T-20 Bulk Milk Tank manufactured by a European licensee, Eurozero, was awarded a gold medallion for its highly technical level, originality of solution, economy of use, sturdy construction, productivity and ease of handling.

CERTIFICATE OF SERVICE

A copy of the foregoing Reply Brief was mailed, airmail first class, to Edmund C. Rogers and John T. Rogers, Esquires, Kingsland, Rogers, Ezell, Eilers & Robbins, 121 South Meramec Avenue, St. Louis, Missouri 63105, and W. E. McIntyre, Jr., Esquire, Brandon, Mississippi, Counsel for Defendant-Respondent, on October 4, 1966.

PENROSE LUCAS ALBRIGHT